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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,647	03/28/2006	Hiroyuki Kikkoji	287631US8PCT	8958
22850	7590	09/05/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER JARRETT, RYAN A	
			ART UNIT 2121	PAPER NUMBER
			NOTIFICATION DATE 09/05/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/573,647

**Applicant(s)**

KIKKOJI ET AL.

**Examiner**

RYAN A. JARRETT

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 July 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-18 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 28 March 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Different Examiner***

It is noted that this case has been assigned to a new examiner. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan A. Jarrett whose telephone number is (571) 272-3742. The examiner can normally be reached on 10:00-6:30 M-F.

### ***Specification***

The disclosure is objected to because of the following informalities:

It appears that the title on page 1 of the specification needs to be updated to match the title in the ADS.

Appropriate correction is required.

### ***Drawings***

It appears that "Fig. 14" should either be cancelled, or described in the specification under the "Brief Description of the Drawings".

***Response to Arguments***

Applicant's arguments, see pg. 12, filed 07/01/08, with respect to claims 1-7 have been fully considered and are persuasive. The 35 U.S.C. 101 rejection of claims 1-7 has been withdrawn.

Applicant's arguments with respect to claims 10 and 11 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites, “wherein said receiving means receives advertisement information corresponding to said device *identification* information in response to said request information” (emphasis added). This is not supported or enabled by the specification since the specification discloses throughout that it is the device *attribute* information, not the device *identification* information, that determines the received attribute information (e.g., see pg. 4 lines 7-10, pg. 4 lines 20-21, pg. 5 lines 5-7, pg. 28 lines 9-19).

Independent claims 7-12 and 18 recite a similar limitation and are thus rejected for the same reason. Dependent claims 2-6 and 13-17 depend from claims 1 and 12 and thus incorporate the same deficiency.

Examiner suggests replacing “identification” with “attribute” at the appropriate location in claims 1, 7-12, and 18 in order to overcome this rejection.

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for said advertising information being information that prompts user registration with said management device (e.g., claim 2) or information that prompts registration for services linked from said management device (e.g., claim 3), does not reasonably provide enablement for an other type of advertisement information contemplated by the broader language of claim 1. For example, the claimed "advertisement" of claim 1 could conceivably be any type of advertisement marketing a product or service to a user, and have nothing to do with a service registration process. For example, the claimed "advertisement" of claim 1 conceivably could merely be a new car demo, or another type of new product demo, and having nothing to do with registering for services. Even an advertisement that tries to get a user to buy a product on the spot cannot be considered a service advertisement that prompts some sort of registration. This breadth of scope is simply not enabled by the specification since the specification is focused specifically on getting an unregistered user to register for a service (particularly a media service), not the broader concept of advertising in general. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims.

Examiner suggests incorporating the features of claims 2 and 3 into claim 1 using Markush language to overcome this rejection, and making similar changes to the other independent claims.

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for said device attribute information including performance of a display device on which said advertisement is displayed (e.g., claim 4), memory capacity of a storage device in which said advertisement information is stored (e.g., claim 5), information regarding the presence of a battery (e.g., claim 6), does not reasonably provide enablement for other possible types of device attributes contemplated by the broad language of claim 1. For example, a device attribute could be a printer attribute, which is not enabled at all in the context of the claimed invention. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims.

Examiner suggests incorporating the features of claims 4-6 into claim 1 using Markush language to overcome this rejection, and making similar changes to the other independent claims.

Claims 12-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no literal support in the original disclosure for the “transmitter”, “receiver”, or “controller” of claims 12-17, or the “first receiver”, “transmitter”, “second receiver”, or “advertisement information transmitter” of claim 18.

Examiner suggests cancelling claims 12-18 to overcome this rejection.



The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is directed to “an information processing device for receiving service advertisement information”. Yet the claim itself does not actually recite “service advertisement” in the body of the claim, only “advertisement”. Therefore, the claim is not accurate and complete under § 112, 2<sup>nd</sup> paragraph, since the claim does not constitute or accomplish the preamble.

Independent claims 7-12 and 18 contain similar deficiencies and are thus rejected for the same reason. Dependent claims 2-6 and 13-17 depend from claims 1 and 12 and thus incorporate the same deficiency.

Examiner suggest changing “advertisement” to “service advertisement” in the body of claims 1-5, 7-16, and 18 in order to overcome this rejection.

***Double Patenting***

Applicant is advised that should claims 1-7 be found allowable, claims 12-18 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claims 12-18 could also be interpreted to invoke 112 6th paragraph, since the claim limitation is written as a function to be performed and does not recite sufficient structure, material, or acts which would preclude application of 35 U.S.C. 112, sixth paragraph. As such, the claims can be considered substantial duplicates.

Examiner suggests cancelling claims 12-18 to overcome this potential objection.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10 and 11 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter. Specifically, the claimed inventions can be interpreted as not falling within at least one of the four statutory categories of patent eligible subject matter recited in 35 U.S.C. 101 (process, machine, manufacture, composition of matter).

The claimed “computer readable medium” of claims 10 and 11 can be interpreted to be a form of energy, such as a signal encoded with functional descriptive material (see pg. 30 line 24: “network...media”). Such signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of § 101.

Examiner suggests replacing “computer readable” in claims 10 and 11 with “storage” to overcome this rejection.

Claim 18 is rejected under 35 U.S.C. 101 because the claimed invention can be interpreted to be directed to non-statutory subject matter. Specifically, the claimed invention can be interpreted to be directed to functional descriptive material: “data structure” representing descriptive material *per se* or computer programs representing computer listings *per se*.

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure’s functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs, are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program’s functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at

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1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

Regarding claim 18, although the claims are directed to a “device”, all of the elements could reasonably be interpreted by one of ordinary skill, in light of the disclosure, to be software, such that the “system” is software, per se, not tangibly stored on a computer-readable storage medium.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN A. JARRETT whose telephone number is (571)272-3742. The examiner can normally be reached on 10:00-6:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ryan A. Jarrett/  
Primary Examiner, Art Unit 2121

08/29/08